

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY-DOCKET NO.
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EXAMINER

SHERRER, C

ART UNIT

PAPER NUMBER

1761

DATE MAILED:

12/18/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/898,736

Applicant(s)
Coppens et al

Examiner
Curtis E. Sherrer

Group Art Unit
1761



☒ Responsive to communication(s) filed on Oct 1, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-42 is/are pending in the application.

Of the above, claim(s) 10-12, 25, 26, and 38-42 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9, 13-24, and 27-34 is/are rejected.

☒ Claim(s) 35-37 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Election/Restriction

1. Applicant's election of Group I in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 10 to 12, 25, 26, and 38 to 42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected inventions. Election was made without traverse in Paper No. 8.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed as BE96/00077, on July 23, 1996. It is noted, however, that applicant has not filed a certified copy of the PCT application as required by 35 U.S.C. 119(b).

Drawings

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

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5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification is not enabled for ATCC numbers 4858, 9363, ^{NRB2}1891, 1472 and 14156. Because Claims 9, 24, and 28 require the organism, it is essential to the practice of the claimed invention. Therefore, applicants must comply with the deposit requirements set forth in 37 CFR 1.801 - 1.809. Specifically, Applicants need to provide an affidavit or declaration by applicant or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney or of record over or her signature and registration number, stating that the strain will be irrevocably and without restriction or condition released to the public upon the issuance of a patent. See 37 C.F.R. 1.808.

Claim Objections

6. Claims 35 to 37 are objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim cannot depend upon another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 35 to 37 have not been further treated on the merits.

7. Claims 29 is objected to because of the following informalities: the Markush group should not refer to organisms contained in articles or books, but rather the specific organisms. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4 to 10, 27, 29 and 31 to 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 35 is considered indefinite because it is unclear as to what is the scope of the phrase “significantly more swollen than their dormant size.”

11. The phrases “preferentially” (Claims 29, 31, and 32) and “such as” (Claim 33) and “preferably” (Claims 27, 34, and 35) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

12. Claim 4 is considered indefinite because the scope of the phrase “obtained by a matter process” is unknown.

13. Claims 7 and 8 are considered indefinite it as it appears to expand on the limitation found in Claim 5.

Claim Rejections - 35 USC § 102/103

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1 to 9, 13 to 24, and 27 to 34 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative rejected under 35 U.S.C. 103(a) as being unpatentable over Gyllang et al (European Brewing Convention (16th Congress)).

Gyllang et al teach "submitting [] barley grains to spore-infected steeping water (page 252). The organisms tested were *Aspergillus fumigatus*, *A. amstelodami* and *Rhizopus oryzae*. It is stated that it "is obvious, therefore, that the three fungi possess proteolytic, amylolytic and other carbohydrate-splitting enzymes which give noticeable effects under the conditions prevailing during the malting process." (Page 248, bottom). It is considered that the added spores are activated spores because they have been grown on medium and then homogenized. This would produce spores that are no longer in the inactive state.

The Office does not have the facilities for examining and comparing Applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed are functionally different than those taught by the prior art and to establish patentable differences. See *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 1977); *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1923 (BPAI).

Even if the prior art did not anticipate the claimed invention it is considered that it would have been obvious to those of ordinary skill in the art to use activated spores rather than inactive spores so that the benefits of Gyllang et al's disclosed increased enzymatic activity would be increased.

While the cited article only states that the malting process involves steeping the barley as described on page 247, it is considered inherent that the broad moisture limitations recited in the claims are inherently met. See *In re Best* above. Even if the cited art does not anticipate the claimed moisture range, it would have been obvious to those of ordinary skill in the art to use standard and notoriously well known moisture contents for the malting process of Gyllang et al as those in the art can select and choose said limitations to optimize the malting process.

Conclusion

16. No claim is allowed.
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
18. Yoshizawa et al (Jap. Pat. No. 354064697) disclose a preparation of malt.
19. Tanaka et al (Jap. Pat. No. 357033593) disclose the production of koji and seed koji.
20. Yoshihiro (Jap. Pat. No. 363094968) discloses the production of granulated seed malt.
21. Soga et al (Jap. Pat. No. 406153896) disclose the production of refined sake.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The **fax phone number** for this Group is (703)-305-3602.

24. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Curtis E. Sherrer', with a long horizontal flourish extending to the right.

Curtis E. Sherrer

December 14, 1998